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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,672	07/20/2001	Werner Zitzmann	Mo-6439/LeA 34,771	1519

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EXAMINER	
TON, THAIAN N	

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 09/26/2002 6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/909,672	Applicant(s) ZITZMANN ET AL.	
	Examiner Thaian N. Ton	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-28* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, 12, 14, 20, 21 and 27 drawn to isolated nucleic acids, vectors and host cells, methods for preparing a polypeptide, classified in class 435, subclass 320.1, 325, class 536, subclass 23.1, for example.

II. Claims 8, 22 and 23 drawn to a transgenic organism, classified in class 800, subclass 3, for example.

III. Claims 9, 10 and 28 drawn to isolated polypeptides, classified in class 530, subclass 350+, for example.

IV. Claim 11, drawn to an antibody, classified in class 530, subclass 387.1, for example.

V. Claim 13, drawn to a process for preparing a nucleic acid, classified in class 435, subclass 91.1.

VI. Claims 15 and 24 drawn to a method for finding new active compounds for crop protection, classified in class 435, subclass 4, for example.

VII. Claim 16, drawn to a method of finding a compound which binds to a polypeptide, classified in class 435, subclass 4, for example.

VIII. Claim 17, drawn to a method for inducibly expressing target genes with a polypeptide in a host cell *in vitro*, classified in class 435, subclass 70.1+.

IX. Claims 25 and 26, drawn to methods for inducibly expressing target genes with a polypeptide *in vivo*, classified in class 800, subclass 3, for example.

The inventions are distinct, each from the other because of the following reasons:

Invention I and any of Inventions II, VI, VII, VIII or IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the isolated nucleic acids can be used to produce protein *in vitro*.

Invention I and III are to distinct products capable of separate use. The nucleic acid of Invention I can be used as a probe in hybridization assays. The isolated polypeptides of Invention III can be used to produce antibodies.

Invention I and IV are to distinct and independent products capable of separate use. The nucleic acid of Invention I can be used to produce protein *in vitro*. The antibody of Invention IV can be used in immunological assays.

Invention I and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case nucleic acids can be prepared by extraction from appropriate tissues.

Invention II and any of Inventions III-VIII are mutually exclusive and independent. The transgenic organism of Invention II is not required for the

implementation of the isolated polypeptides of Invention III, the antibody of Invention IV, the process for preparing a nucleic acid of Invention V, the method for finding new active compounds for crop protection of Invention VI, the method of finding a compound which binds to a polypeptide of Invention VII, and the method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII, and vice versa.

Inventions II and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic organism can be used to produce cell lines.

Invention III and Invention IV are distinct because they are of separate uses. The isolated polypeptides of Invention III can be used in a protocol to produce hybridomas. The antibody of Invention IV can be used in immunological assays.

Invention III and any of Inventions V, VI, VIII and IX are mutually exclusive and independent. The isolated polypeptides of Invention III are not required for the process for preparing a nucleic acid of Invention V, the method for finding new active compounds for crop protection of Invention VI, the method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII

and the methods for inducibly expressing target genes with a polypeptide *in vivo* of Invention IX, and vice versa.

Inventions III and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the isolated polypeptides can be used in a protocol to produce hybridomas.

Invention IV and any of Inventions V-IX are mutually exclusive and independent. The antibody of Invention IV is not required for the implementation of the process for preparing a nucleic acid of Invention V, the method for finding new active compounds for crop protection of Invention VI, the method of finding a compound which binds to a polypeptide of Invention VII, the method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII and the methods for inducibly expressing target genes with a polypeptide *in vivo* of Invention IX, and vice versa.

Invention V and any of Inventions VI-IX are mutually exclusive and independent. The process for preparing a nucleic acid of Invention V is not required for the implementation of the method for finding new active compounds for crop protection of Invention VI, the method of finding a compound which binds to a

polypeptide of Invention VII, the method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII and the methods for inducibly expressing target genes with a polypeptide *in vivo* of Invention IX, and vice versa. Furthermore, each of the methods requires a separate and materially different protocol.

Invention VI and any of Inventions VII-IX are mutually exclusive and independent. The method for finding new active compounds for crop protection of Invention VI is not required for the implementation of the method of finding a compound which binds to a polypeptide of Invention VII, the method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII and the methods for inducibly expressing target genes with a polypeptide *in vivo* of Invention IX, and vice versa. Furthermore, each of the methods requires a separate and materially different protocol.

Inventions VII and either of Inventions VIII or IX are mutually exclusive and independent. The method of finding a compound which binds to a polypeptide of Invention VII is not required for the implementation of the method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII and the methods for inducibly expressing target genes with a polypeptide *in vivo* of Invention IX, and vice versa. Furthermore, each of the methods requires a separate and materially different protocol.

Inventions VIII and IX are mutually exclusive and independent. The method for inducibly expressing target genes with a polypeptide in a host cell *in vitro* of Invention VIII is not required for the implementation the methods for inducibly expressing target genes with a polypeptide *in vivo* of Invention IX, and vice versa. Furthermore, each of the methods requires a separate and materially different protocol.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thaian N. Ton whose telephone number is (703) 305-1019. The examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time), with alternating Fridays off. Should the examiner be unavailable, inquiries should be directed to Deborah Reynolds, Supervisory Primary Examiner of Art Unit 1632, at (703) 305-4051. Any administrative or procedural questions should be directed to Patsy Zimmerman, Patent Analyst, at (703) 305-2758. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703)872-9306.

Deborah Crouch

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TNT

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